

REMARKS

In the May 15, 2008 Office Action, the Examiner noted that claims 1-17 were pending in the Application. Claims 1, 3, 4, 6, 9 and 14 have been amended herein. Thus, claims 1-17 remain pending for consideration, which is respectfully requested. Support for the amendments can be found in the Specification as filed, for example, on page 8, line 36 to page 9, line 7, and Figure 6.

Objection to the Claims

On page 10, the Office Action objected to claims 1 and 4. The claims have been amended herein to recite "means for recording" for clarification purposes.

In addition, the Office Action objected to the claims for reciting "recorded use results" as shown in the example for claim 1. Claim 1 has been amended to recite "recorded use result information." Contrary to the assertion by the Office Action, Applicants submit that such a clarification is not needed in any other claims.

In view of the above, Applicants request the objections be withdrawn.

Rejection under 35 U.S.C. § 112

On page 10, the Office Action rejected claims 1, 3 and 4 (including their dependent claims) under 35 U.S.C. § 112, second paragraph for reciting "making a payback to a user or a middleman/distributor," whereas the preamble recites "making a payback to both the user and the middleman/distributor." Applicants have amended the preambles of claims 1, 3 and 4 herein for clarification purposes. For example, claim 1 has been amended to recite "making payback to at least one of a product user and a middleman" (lines 1-2).

In view of the above, Applicants request the rejection be withdrawn.

Rejection under 35 U.S.C. § 102(e)

On page 11, the Office Action rejected claims 1-5, 10-13 and 17 under 35 U.S.C. § 102(e) as being anticipated by Heinz (U.S. Patent Publication 2001/0025253 A1). This rejection is respectfully traversed.

Applicants submit that Heinz is not a proper prior art reference, because the priority filing date of the present application is January 5, 1999, which precedes the effective date of Heinz as a reference under 35 U.S.C. § 102(e), which is February 8, 2000 (i.e. filing date of provisional application).

The Applicants submit herewith a verified English translation of the foreign priority application (Japanese Patent Application No. 11-000425) of the present U.S. patent application, concurrently herewith under 37 CFR 1.55. Therefore, foreign priority of the present U.S. patent application is perfected; thereby overcoming the effective filing date of Heinz relied upon by the Examiner in rejecting claims 1-5, 10-13 and 17.

Therefore, withdrawal of the rejection is respectfully requested.

Rejections under 35 U.S.C. § 103(a) and § 102(b)

On page 13, the Office Action rejected claims 6-9 and 14-16 under 35 U.S.C. § 103(a) as being unpatentable over Brewer (U.S. Patent 6,148,332 A). On page 20, the Office Action rejected claims 6-9 and 14-16 under 35 U.S.C. § 103(a) as being unpatentable over Shear (U.S. Patent 4,827,508). These rejections is respectfully traversed.

Claim 6 as amended recites "storing use result information, including **a period of use and functions used... calculating a payback** value to be paid to the distributor by the network service provider **based on** the customer identification information... and on **the stored use result information**" (lines 13-19). Applicants submit that Brewer, Shear, and Official Notice, taken alone or in combination, fail to describe such a feature.

In response to Applicants' previous arguments, the Office Action on page 3, third paragraph, stated it is unclear how the use results are associated with the distributed product. Applicants submit that the amendments as shown above, further clarify that the use result information includes information about a period of use and information regarding the functions used. As a result, the calculated payback is based upon such information.

On page 16, last line, to page 17, lines 1-2, the Office Action concedes that Brewer does not disclose calculating or paying, by the ISP, a fee to the distributor. On page 22, third paragraph bold portion, the Office Action concedes that Shear does not disclose calculating or paying, by the Publisher or Provider, a fee to the distributor. The Office Action, however, relies on the AOL.com example as described, for example, on page 18, first paragraph bold portion (see also page 22, last paragraph), as curing the deficiencies of Brewer and Shear describe above. As described by the Office Action in the AOL.com example, the payback fee is calculating based upon distributing the diskettes or CDs and AOL.com's server is configured to identify the unique diskettes (e.g. temporary login and password) distributed by a particular user. This allows for the payback fee to be determined based upon a successful registration of a user. In other words, the payback in the AOL.com example is only concerned about an initial registration without regard to the duration that the particular service is used. In addition, the

AOL.com example not is concerned with which services are used (e.g. only the one service of AOL is used). Accordingly, nothing in the Office Action's examples describe calculating a payback based on a period of use or the function used.

Furthermore, the Office Action, page 18, second paragraph, alleges that the payback feature is a non-functional descriptive material. Applicants submit that in view of the clarifying amendments herein, the payback is calculated based on period of use and functions used. Therefore, Applicants submit that the payback feature is not a non-functional descriptive material.

In view of the above, Applicants submit that the combination of Brewer, Shear, and Office Notice fail to disclose "storing use result information, including **a period of use and functions used... calculating a payback** value to be paid to the distributor by the network service provider **based on** the customer identification information... and on **the stored use result information**" as recited by claim 6.

Independent claim 9 recites "storing use result information, including a period of use and functions used... calculating a payback value to be paid to the distributor by the network service provider based on the customer identification information... and on the stored use result information" (lines 14-22), and therefore, patentably distinguishes over the cited art.

Independent claim 14 recites "storing use result information of services, including a period of use and functions used... a payback calculation device calculating a payback value to be paid to the distributor by the network service provider based on the customer identification information... and on the stored use result information" (lines 13-20), and therefore, patentably distinguishes over the cited art.

The remaining dependent claims inherit the patentable recitations of their respective base claims, and therefore, patentably distinguish over the cited art for the reasons discussed above in addition to the additional features recited therein.

Conclusion

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Serial No. 09/883,913

If there are any additional fees or credits associated with filing of this response, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date: 10-15-08

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